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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/809,874 | 03/26/2004 | Ryoichi Fukumoto | 741440-58 | 7617 |
| 22204 | 7590 | 04/06/2006 | EXAMINER | |
| NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128 | | | ROBINSON, BINTA M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1625 | |

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,874

Applicant(s)

FUKUMOTO ET AL.

Examiner

Binta M. Robinson

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. . .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Detailed Action

Applicant is advised that should claim 12 be found allowable, claim 13 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In line 1 of claims 9-14, the term "agent" is not a statutory invention and is unclear. Does the applicant mean a compound or "composition"?

B. In claim 3, line 11, page 2 and everywhere else throughout claims 4-25, the term "acyl" group is unclear because acyl containing groups are also claimed in the claims such as carbamoyl, group. The specification at page 6, lines 6-7 only gives examples of what acyl groups can be but no definitive listing.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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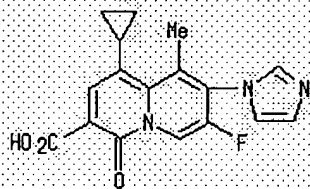
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-6, 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by

Chu et. al.

Chu et. al. discloses the instant compound,

L1 ANSWER 1 OF 1 REGISTRY COPYRIGHT 2006 ACS on STN
RN 169749-03-5 REGISTRY
ED Entered STN: 07 Nov 1995
CN 4H-Quinolizine-3-carboxylic acid, 1-cyclopropyl-7-fluoro-8-(1H-imidazol-1-yl)-9-methyl-4-oxo-, monohydrochloride (9CI) (CA INDEX NAME)
MF C17 H14 F N3 O3 . Cl H
SR CA
LC STN Files: CA, CAPLUS, TOXCENTER
CRN (180976-00-5)



. At page 396, line 1, see the instant compound

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu et. al.. (See Reference N).

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Chu et. al. teaches the instant compound as shown in Formula I, where R1 is cycloalkyl of from three carbon atoms, R2 is phenyl, or nitrogen-containing aromatic heterocycle, R3 is selected from the group consisting of hydrogen, halogen, R4 is selected from the group consisting of hydrogen, loweralkyl, and a prodrug ester group, R5 is selected from the group consisting of hydrogen, A is CR6, wherein R6 is hydrogen, halogen, loweralkyl, loweralkoxy, provided that, when R5 is hydrogen, and A is CH-, R1 is not unsubstituted phenyl. At pages 383-385, see the compound of formula I and, see the radicals defined. These compounds are antibacterial compounds as are the instant compounds.

The prior art teaches a limited number of selections for the variables of this genus that are small enough in number to be combined to form the instant genus. Since the prior art teaches a limited group of antibacterial compounds within a genus that overlaps in subject matter with the instant genus, it would have been obvious for one of ordinary skill in the art to easily envision and test the compounds that overlap with the prior art genus of compounds, compounds which are antibacterial compounds like the compounds of the prior art. Accordingly, the compounds are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)-272-1600.



BMR
April 3, 2006



Cecilia J. Tsang
Supervisory Patent Examiner
Technology Center 1600